



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: )  
Bruce TOGNAZZINI ) Group Art Unit: 3621  
Application No.: 08/655,136 ) Examiner: Calvin L. Hewitt II  
Filed: May 30, 1996 ) Confirmation No. 8272  
For: CATALOG PHONE SALES )  
TERMINAL )

**Mail Stop Appeal Brief--Patents**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**REPLY BRIEF UNDER 37 C.F.R. § 1.193**

Pursuant to the provisions of 37 C.F.R. § 1.193, this Reply Brief is filed in response to the Examiner's Answer dated January 25, 2005. This Reply Brief is timely filed because it is filed within two months of the mailing date of the Examiner's Answer.

Claims 1, 5-10, 15, and 22-28 are pending in this application. In his Answer, the Examiner maintained his rejections of claims 5-10, 15, and 22-28 as being unclear under 35 U.S.C. § 112, second paragraph. The Examiner also maintained his rejections under 35 U.S.C. § 103(a) of claims 1 and 21 over *Rose et al.*, U.S. Patent No. 5,757,917, in view of *Sandig et al.*, U.S. Patent No. 5,737,610, and *Remillard*, U.S. Patent No. 5,396,546; claims 15 and 28 over *Bezos*, U.S. Patent No. 5,715,399, in view of *Bezos*, U.S. Patent No. 5,727,163, and *Dedrick*, U.S. Patent No. 5,717,923; and claims 5-10 and 22-27 over *Feldman*, U.S. Patent No. 5,343,519,

in view of *Winebaum et al.*, U.S. Patent No. 4,941,172. For at least the reasons set forth below, these rejections should be reversed.

**A. Section 112 rejections of claims 5-10, 15, and 22-28**

In the Answer, the Examiner continued to reject claims 5-10 and 22-27 under 35 U.S.C. § 112, second paragraph, arguing that because the seller memory is not part of the claimed device, “the Applicant has not clearly defined the subject matter that the Applicant regards as the invention.” (Examiner’s Answer, pp. 6-7.) Claim 5 recites a device that includes, among other things, “a docking port for receiving information from an external memory...wherein said information comprises card information relating to a telephone purchase and is received from a seller memory connectable to said external memory.” Claim 22 recites a method in a portable device including “receiving, by a docking port in the portable device, information from an external memory, wherein said information...is received from a seller memory connectable to the external memory.” Appellant respectfully submits that claims 5 and 22 plainly state that the docking port is for receiving information from an external memory and that the information is received from a seller memory connectable to the external memory.

Because claims 5 and 22 distinctly point out and claim aspects of the device and define a relationship between the device, an external memory, and a seller memory, the claims fully comply with § 112, second paragraph. Claims 6-10, which depend from claim 5, and claims 23-27, which depend from claim 22, are also fully compliant with section 112 for at least the reasons given in connection with claims 5 and 22. Because claims 5-10 and 22-27 particularly point out and distinctly claim aspects of the subject matter which Appellant regards as the invention, the section 112 rejections should not be sustained.

In the Answer, the Examiner also rejected claim 15 under 35 U.S.C. § 112, second paragraph, stating that it does not clearly define the subject matter of the invention because the relationship between the claim elements is unclear. In particular, the Examiner argued that the claim elements describing the customer telephone and the seller telephone do not recite placing an order. (Examiner's Answer, p. 13.)

Claim 15 recites, among other things, a telephone at a customer site, a telephone at a seller site, and a telephone network connecting said telephone at a customer site with said telephone at a seller site while an order for goods is placed. Therefore, argues the Examiner, the first two claim elements could describe an exchange of information prior to ordering, such as registration. (Id.) Appellants do not disagree. And while this interpretation may make the claim broad, it does not render it unclear. Therefore, Appellant requests the reversal of the section 112 rejection of claim 15.

The Examiner made the same objections to claim 28, which recites a method including the steps of providing a telephone at a customer site, storing information in a memory of a telephone at a seller site, and connecting, by a telephone network, said customer telephone with said seller telephone while said order is placed. As with claim 15, just because claim 28 may be broad, it is not unclear, and Appellant requests the reversal of the section 112 rejection of claim 28.

Because claims 5-10, 15, and 22-28 clearly recite matter which Appellant regards as the invention, the rejections under 35 U.S.C. § 112, second paragraph, should not be sustained.

**B. Section 103 rejections of claims 1 and 21**

The Examiner maintained his rejections under 35 U.S.C. § 103(a) of claims 1 and 21 over *Rose et al.*, U.S. Patent No. 5,757,917, in view of *Sandig et al.*, U.S. Patent No. 5,737,610, and *Remillard*, U.S. Patent No. 5,396,546. Even accepting the Examiner's interpretation of the references and claims as correct, the combination of *Rose et al.*, *Sandig et al.*, and *Remillard* fails to disclose every element of claims 1 and 21.

Claim 1 recites, among other things, an apparatus comprising a card reader for reading card information and sending it to one called station, data memory for storing information, including the card information, from one of the called stations, and a key for activating the data memory to send the stored information to another called station. As the Examiner correctly states, *Rose et al.* discloses a buyer computer that sends a message with a card number to a seller computer that in turn sends a payment request message including the card number to a payment system. (*Rose et al.*, col. 8, ll. 1-26; Figs. 6A-6B.) In the Answer, the Examiner argues that the buyer computer of *Rose et al.* is the called station of claim 1, the seller computer is the data memory, and the payment system is the another called station. (Examiner's Answer, p. 15.) The Examiner then cites *Remillard* as teaching a card reader connected to a phone line as a suitable means for transmitting card information from the buyer. (*Id.*)

Even if the buyer computer of *Rose et al.* could be modified to include the card reader of *Remillard*, the card information would be read using a card reader at the modified buyer computer, sent to the seller computer, and then sent from the seller computer to the payment system. Following the Examiner's line of reasoning, the seller computer, and not the buyer computer, would have to be the claimed called station. However, the Examiner has shown no

teaching in *Rose et al.* of the buyer computer sending anything to the payment system that might correspond to the claimed apparatus comprising a key for activating the data memory to send said stored information to another of the called stations. Thus, even accepting the Examiner's interpretation of the references, there is still no teaching shown of an apparatus comprising a card reader for reading card information and sending it to one called station over a data interface, data memory for storing information, including the card information, from one of the called stations, and a key for activating the data memory to send the stored information to another called station. Furthermore, the Examiner has not alleged that *Sandig et al.* cures this defect. Instead, *Sandig et al.* is merely cited as teaching a docking port for receiving a portable device. Because the Examiner has not shown a teaching of each claim element in the cited references, the section 103 rejection of claim 1 should be reversed.

Claim 21 recites a method including the steps of reading card information by a card reader, sending the card information by the card reader to one called station over a data interface, storing information including the card information in data memory, and activating the data memory to send the stored information to another of the called stations. As discussed above with respect to claim 1, the combination of *Rose et al.*, *Remillard*, and *Sandig et al.* fails to teach this combination of claim elements. Thus, the section 103 rejection of claim 21 should be reversed.

### **C. Section 103 rejections of claims 15 and 28**

The Examiner maintained his rejections under 35 U.S.C. § 103(a) of claims 15 and 28 over *Bezos*, U.S. Patent No. 5,715,399, in view of *Bezos*, U.S. Patent No. 5,727,163. These rejections should not be sustained at least because the Examiner failed to show that the references, taken alone or together, teach or suggest a system including a seller telephone that

sends information to a customer memory for use during a subsequent transaction. The Examiner has further failed to show that the references, taken alone or together, teach or suggest a system including a seller telephone that determines whether a customer telephone is memory equipped.

In his Answer, the Examiner first argues that claims 15 and 28 do not recite this claim element. (Examiner's Answer, pp. 16-17.) Claim 15 recites "a telephone at a customer site having a customer memory for storing and sending information" and "**a telephone at a seller site having a seller memory and a display for respectively...sending information stored in said seller memory to said customer memory for use during a subsequent order.**" Claim 28 recites "**sending information stored in said seller memory from said telephone at the seller site to said customer memory for use during a subsequent order.**" Although Appellant may have paraphrased the claim language slightly in making his argument, claims 15 and 28 clearly contain the recitation at issue.

The Examiner next argues that *Bezos '399* discloses a seller that sends information to a customer telephone and displays the information on the customer telephone. (Examiner's Answer, pp. 16-17.) However, the Examiner's argument depends on his flawed assertion that because "a computer connects to the internet over a telephone using a modem, ... the customer and seller computer are telephones." (Examiner's Answer, p. 17.) Claim 15 plainly recites a telephone at a customer site and a telephone at a seller site. Claim 28 recites a method including providing a telephone having a customer memory and storing information in a seller memory of a telephone at a seller site. In this case, the specification clearly describes "a telephone (100) with a standard keypad (130) and a wired connection to the local phone company (160)." (Specification, p. 11; Fig. 1). The Examiner's attempt to twist the meaning of telephone to cover

any computer with a modem must fail. Therefore, his rejections of claims 15 and 28 based on this flawed interpretation must be reversed.

The Examiner further argues that *Bezos* '399 discloses a telephone at a seller site having a seller memory and a display for confirming whether a customer telephone is memory equipped. (Examiner's Answer, p.18.) In particular, he states that a seller can provide advertisements "based on whether a customer telephone ('399, figure 1, items 18 and 29) is memory equipped such as the means (e.g., software, hardware, peripherals) with which the customer computer/telephone processes audio, video, text and graphic data." (Id.) Again, the Examiner blurs the definition of telephone to include the computer 18 shown in *Bezos* '399, and again the Examiner's resulting rejections of claims 15 and 28 must therefore fail.

**D. Section 103 rejections of claims 5-10 and 22-27**

The Examiner maintained his rejections under 35 U.S.C. § 103(a) of claims 5-10 and 22-27 over *Feldman*, U.S. Patent No. 5,343,519, in view of *Winebaum et al.*, U.S. Patent No. 4,941,172. These rejections should not be sustained at least because the Examiner has failed to show that the references, taken alone or together, teach or suggest a device including a docking port for receiving information comprising card information relating to a telephone purchase from a seller memory and loading said information into a device memory.

In the Answer, the Examiner first argues that this point of distinction relies upon non-functional data and intended use. (Examiner's Answer, p. 19.) According to the M.P.E.P., the use of a wherein clause may raise a question as to the effect of the claim language, but it does not automatically render the language as nonfunctional. (M.P.E.P. § 2106(II)(c).) In particular, language that "suggests or makes optional" does not limit claim scope. (Id.) In this case,

however, the language of the wherein clause serves to further define a claim term, i.e., “information” that is received from an external memory and loaded into a device memory. What comprises the information (i.e., “card information relating to a telephone purchase”) is part of the claim scope, and Examiner’s objection to this language as non-functional is misplaced.

The Examiner next argues that *Winebaum et al.* discloses a device including a docking port for receiving information comprising card information relating to a telephone purchase because the reference states that a portable device may be a credit card. (Examiner’s Answer, p. 19.) The reference states that its autodialer may be incorporated into a credit card. (*Winebaum et al.*, col. 2, ll. 36-40.) However, the fact that the device in *Winebaum et al.* may be a credit card does not disclose or suggest receiving information comprising card information relating to a telephone purchase. The reference further states that its autodialer is preprogrammed with a telephone number that may be used to access telephone services, such as dial-a-joke or a television home shopping network. (*Winebaum et al.*, col. 3, ll. 30-50.) A telephone number used to access a service is not the same as card information relating to a telephone purchase.

The Examiner further argues that the external memory of the claim is nonfunctional data, because it does not alter how the machine functions. (Examiner’s Answer, pp. 19-20.) Regarding classifying claim language as functional or non-functional, the M.P.E.P. cautions Examiners to consider the claimed invention as a whole to determine whether the necessary functional interrelationship is present. (M.P.E.P. §§ 2106(VI), 2106(IV)(B)(1).) When read in their entirety, claims 5 and 22 recite an interrelationship between a device memory, an external memory, and a seller memory connectable to said external memory. The structure and function



of these claim elements is part of the invention of claims 5 and 22, and the Examiner is wrong to dismiss parts of the structure as “non-functional.”

Finally, the Examiner states that the presence of an external memory in *Feldman* is inherent or at least obvious. (Examiner’s Answer, p. 20.) *Feldman* discloses a central preprogramming station that an autodialer may be inserted into for programming. The central preprogramming station stores a telephone number, personal identification code, or credit card number on the autodialers. (*Feldman*, col. 4, ll. 42-55; Figure 4.) The Examiner’s argues that the data in the preprogramming station of the reference must come from somewhere, be it a person’s memory or a computer memory. Therefore, continues the Examiner, “the presence of external memory to load data into a docking station is not invention.” (Examiner’s Answer, p. 20.)

Appellants note that when applying 35 U.S.C. § 103, the claimed invention must be considered as a whole. (M.P.E.P. § 2141, citing *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 (Fed. Cir. 1986).) Thus, it is error for the Examiner to isolate one part of the claim (e.g., an external memory) and use it as the basis for his rejection. Furthermore, even if *Feldman* inherently or obviously includes an external memory, nothing in the reference teaches or suggests that card information relating to a telephone purchase is received from a seller memory connectable to an external memory and loaded into a device memory.

Because neither *Feldman* nor *Winebaum et al.*, taken alone or together, teach or suggest all of the elements of claims 5 and 22, the section 103 rejections of claims 5 and 22, and the claims that depend therefrom, should be reversed.

**E. Conclusion**

In view of the foregoing remarks, it is respectfully requested that the final rejections of claims 1, 5-10, 15, and 21-28 be reversed.

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Respectfully submitted,

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Dated: March 17, 2005

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